

REMARKS

By the present amendment, dependent claim 6 has been added. Support for the subject matter of this claim may be found on lines 22-25 of page 13 of the present specification. Entry of these amendments is respectfully requested.

In a final Office Action dated May 20, 2003, claims 1 to 5 were rejected under the first paragraph of 35 USC § 112 as not being enabled by the specification as filed. In particular, it was asserted that (a) the translation of Japanese Industrial Standard JIS-8148 was insufficient since it is dated subsequent to the filing date of the application, and (b) the composition "polyvinyl alcohol-cation monomer graft copolymer" is not enabled since one of ordinary skill in the art would not be able to obtain these materials. Reconsideration of this rejection in view of the attached document and the following comments is respectfully requested.

In response to (a) above, applicants previously submitted an English language version of the subject JIS Standard. This submission was objected to since it was not dated prior to the filing date of the application. Consequently, a 1993 version of the Standard in the Japanese language was submitted. This was deemed insufficient by the examiner by not being in English as of the filing date of the application.

More specifically, the examiner identified the issue as one of incorporation of

essential material by reference. According to the controlling provisions in Section 608.01(p) of the MPEP, the incorporation of essential material by reference to a publication is remedied by amending the disclosure to include the material incorporated by reference and to submit a declaration stating that the amendatory material consists of the same material incorporated by reference. Thus, as a first step, submitted herewith is a verified translation of the previously submitted JIS Standard.

Further, it is submitted that the assertion that the Standard be available in English at the time the applicants filed their application is not accurate. A review of the provisions of Section 608.01(p) of the MPEP indicates no such requirement either for essential or nonessential material incorporated by reference. In fact, the MPEP recognizes that nonessential material may be incorporated by reference to patents or applications in foreign countries with no reservations as to language.

In response to portion (b), applicants already submitted various materials showing that suitable cationic fixing agents are available from Hymo Co., Ltd. of Japan. The examiner now questioned whether one of ordinary skill in the art would be able to obtain these agents without knowing how to read or speak Japanese.

It is submitted that one of ordinary skill in the art located in the United States would be able to obtain these materials without difficulty. Most Japanese companies are capable of transacting business in English. Applicants advise that Hymo Co., Ltd. of Japan has a

website at <http://www.hymo.co.jp/index.html> which is partially in the English language.

However, even if this particular company were not capable of conducting business in English at all, it would not take a great deal of effort for any person in the United States to locate another person here who would be capable of communicating with them in the Japanese language. While obtaining such a person may entail the expenditure of funds, certainly the costs would not be prohibitive and it would not be a difficult endeavor to do so.

For the reasons set forth above, withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1-5 again were rejected under 35 USC § 103(a) as being unpatentable over the patent to Koide et al in view of the patent to Yasuda et al and the European patent publication to Koji et al for the reasons of record. As before in making this rejection, it was asserted that the patent to Koide et al teaches a recording paper with a coating composition as set forth in the claim 1 and with the properties as recited in claim 1. Without specifically so stating, it apparently was acknowledged that the disclosed recording paper does not include a cationic fixing agent as defined in claim 1. Then, apparently reliance was made upon the secondary patent to Yasuda et al for teaches the inclusion of such an agent and also for teaching a cationic polyvinyl alcohol copolymer apparently in reference to the specific subject matter of claim 3. The Koji et al patent publication

apparently was relied upon for teaching the additional subject matter of claims 2 and 5. Reconsideration of this rejection in view of the following comments is respectfully requested.

In the last response, applicants submitted evidence in the form of a Declaration under 37 CFR § 1.132 which presented experimental evidence regarding the products according to the Koide et al patent which demonstrated unexpected or surprising results for the claimed recording paper relative to the recording paper of the cited Koide et al patent. The examiner responded to this Declaration by asserting that one of ordinary skill in the art would have expected at least some of the improvements obtained with the use of such an agent.

In support thereof, the examiner cited two portions from the Yasuda et al patent which allegedly teach the inclusion of a cationic polymer and the beneficial results achieved thereby. From this teaching, the examiner concluded that the purpose of such agents is to fix dye or pigment in the recording layer which would lead to an increase in image density, water resistance and image reproducibility and motivate one of ordinary skill to include such agents in the recording sheet of the Koide et al patent.

In support of the patentability of the subject invention over the teachings of the cited patents, it is submitted that one of ordinary skill in the art would not be motivated to combine their teachings in the manner proposed by the examiner. In this regard and as

described above, the former portion of the Yasuda et al patent relied upon by the examiner (col. 7, lines 23-25) for showing beneficial results does not relate to a cationic fixing agent, but rather relates to a cationic copolymer used as the binder for the disclosed recording sheet. It is further noted that it is specifically stated at col. 7, lines 23-25 that this binder is water-insoluble.

The latter portion of the Yasuda et al patent relied upon by the examiner (col. 9, lines 36-40) for showing beneficial results apparently does relate to a cationic polymeric substance which functions as a water-proof agent. While such may be considered to be basically the same as a cationic fixing agent of the subject invention which does provide water resistance, it is submitted however that one of ordinary skill in the art would not be motivated to use such a substance according to the patent with a water-soluble binder as in the presently claimed ink jet recording sheet. In support thereof, the Yasuda et al patent teaches at col. 9, lines 36-39 that the water-proof agent must be water-soluble and further that it is taught that this agent is to be used in conjunction with a water-insoluble binder.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 103(a) and allowance of claims 1 through 6 as amended over the cited patents are respectfully requested.

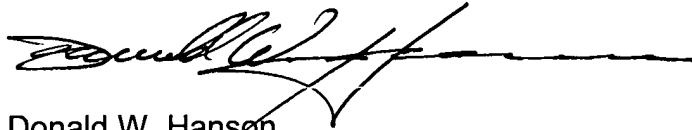
In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

Serial Number: 09/673,567

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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